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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/04/2004

Jan Hall

21547/0286

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30678

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01/06/2009

CONNOLLY BOVE LODGE & HUTZ LLP

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SUITE 1100

WASHINGTON, DC 20006

EXAMINER

SWEET, THOMAS

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/980,011	Applicant(s) HALL ET AL.	
	Examiner Thomas J. Sweet	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,23,25 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,23,25 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03 October 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, see page 6, filed 10/03/2008, with respect to double patenting have been fully considered and are persuasive. The rejection of claims 1-6, 9 and 22 unpatentable over claims 1-3, 5 and 8 of U.S. Patent No. 7048541. has been withdrawn.

Applicant's arguments, see page 6, filed 10/03/2008, with respect to double patenting have been fully considered and are persuasive. The objection of claim 29 as being a duplicate of claim 9 has been withdrawn.

The provisional double patenting rejections are held in abeyance until allowable subject matter is indicated.

Applicant's arguments filed 10/03/2008 have been fully considered but they are not persuasive. The argument that Hunter et al (US 6447550) teaches away from highly porous is not persuasive. Column 4 of Hunter et al clearly sets out the teaching of high porosity to promote ingrowth optimization of that porosity is a matter of routine experimentation which isn't patentably distinct from Hunter et al.

Election/Restrictions

Newly submitted claim 32 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The elected claims were to implant material. The hole implant claims were non elected. A dental implant is not an implant material

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claim 32 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting (held in abeyance)

Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-9 of copending Application No. 10/482727. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in intended use which claims 1 and 7-9 (727) inherently meet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-5, 7 and 10 of copending Application No. 10/482737. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in intended use which claims 4-5, 7 and 10 (737) inherently meet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-23, 25 and 29-31 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al (US 6447550). Hunter et al discloses an implant (abs) comprising titanium and having one or more surfaces which can be applied in or on tissue areas and/or bone growth areas, one or more of the said surfaces being arranged with a depot for bone-growth-initiating (Osseointegration col 4, lines 16-19 and lines 39-44) or bone-growth-stimulating substance (non-elected member of this Markush group), which depot is formed by a pore arrangement in a relatively thick oxide layer on the titanium (3-7 and up to 10 microns thick of approx. 2 micron dia. grains forming pores in between, col 6-7, lines 66-17), characterized in that the substance (non elected) , for a period of time, is acted on by, or works with, one or more release functions which permit a preferably essentially controlled release of substance to the respective surrounding tissue or tissue/bone growth areas. However, Hunter et al does not expressly disclose with 1×10^7 - 1×10^{10} pores/cm². It has been held that it is not inventive to discover the optimum or workable ranges by routine experimentation and would be an obvious extension of the prior art teachings.

Regarding claims 2, 4 and 5, rejected as being directed to a non-elected member of the Markush group.

Regarding claims 3 and 6, pores with different pore characteristics (inherent, random size and distribution).

Conclusion

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This is a RCE. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:45am - 5:15pm, Tu-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas J Sweet/

Primary Examiner, Art Unit 3774